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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/944,234	10/06/97	KUNZLER A	P1178USA

QM12/1214

HILL & SIMPSON
85TH FLOOR SEARS TOWER
CHICAGO IL 60606

EXAMINER	
NGO,L	
ART UNIT	**PAPER NUMBER**
3731	20

DATE MAILED: 12/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/944,234	Applicant(s) Kunzler et al.
	Examiner Lien Ngo	Group Art Unit 3731

☒ Responsive to communication(s) filed on *11-8-99*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-24* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-24* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Gary Jackson 12/13/99
GARY JACKSON
PRIMARY EXAMINER
GROUP 3300

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 11/8/99 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/944234 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Objections

2. Claim 1 is objected to because of the following informalities: In the Preliminary amendment accompanying CPA application filled on 11/8/99 and in the amendment of the claims, "Claim 1, line 3, after " of" insert --the opposing--" is indefinite, because there are two " of" in line 3 of claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

An anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a

claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claims are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. See, for example, Standard Havens Products Inc. v. Gencor Industries Inc., 953 F.2d 1360, 21 USPQ2d 1321 (Fed. Cir. 1991).

4. Claims 1-7, 13-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Scheicher (4,197,645). Scheicher discloses, in figs.1-4 and 13-18, a drill head and bone drill which could be used as a milling apparatus for preparing surfaces of two opposing vertebral bodies to accept a predetermined shape of an endoprosthesis, comprising: a drill head 11, a rotary form cutter 5, a drive means 40, elongate housing 3, said form cutter has a convex shape, a groove, and provided with a beveled gearing surface 37 , the profile of the form cutter is approximately 9 mm, as disclosed in col.7, line 56, said drive means having a pinion gear 39, and said cutter having a support shaft 8 which forms an angle approximately 96 degrees to the drive means.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one of ordinary skill in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA) 1975. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

6. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheicher in view of Tschudin (4, 781,072). Scheicher disclose the inventions substantially as claimed. However, Scheicher does not discloes the drive comprising a belt. Tschudin teaches , in fig. 6 and col.10, lines 1-7, a bone drill having a belt 175. Therefore, it would having ordinary skill in the art at the same time the invention was made, in view of Tschudin, to modify the invention of Scheicher having a drive means including a belt in order to drive the invention with a belt.

Conclusion

7. Applicant's amendment and remarks have been considered. However, they are not convincing as shown in the rejection.

8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Ngo whose telephone number is (703) 305-0294. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, Michael Buiz, can be reached at (703)308-0871. The Group FAX number is (703) 305-3590.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 308-0858.

Gary Jackson 12/13/99

GARY JACKSON
PRIMARY EXAMINER
GROUP 3300

Lien Ngo

December 9, 1999